

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion is respectfully requested.

Claims 1-2, 5-6, 10-16, 19, 20, 24-28, 43, 44, 46-58, 61-70 and 73 are pending in the application; Claims 1, 5, 15, 19, 43, 44, 46, 54, 57, 61, 68, 70 and 73 are amended; and Claims 3-4, 17-18, 59-60 and 71-72 are canceled without prejudice or disclaimer by the present amendment. Claims 1, 15, 43, 44, 46, 54, 57, 68 and 70 are amended to incorporate subject matter similar to that recited by canceled Claims 3-4, and Claims 5, 19, 61 and 73 are amended so as to not depend from presently canceled claims. No new matter is presented.

By way of summary, the Official Action presents the following issues: Claims 70-73 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter; Claims 1-2, 6, 15, 16, 20, 43, 44, 46-54 and 70 were rejected under 35 U.S.C. §102(e) as anticipated by Nagata et al. (U.S. Patent Publication 2004/0047612, hereinafter "Nagata"); Claims 55-58, 62 and 68-69 were rejected under 35 U.S.C. §103(a) as unpatentable over Nagata; and Claims 3-5, 10-14, 17-19, 24-28, 59-61, 63-67, and 71-73 were rejected under 35 U.S.C. §103(a) as unpatentable over Nagata in view of Fujinami et al. (U.S. Patent 6,363,212, hereinafter "Fujinami").

Regarding the rejection of Claims 70-73 under 35 U.S.C. § 101, that rejection is respectfully traversed.

MPEP § 2106 discusses statutory subject matter in relation to data structures of a computer readable medium. Particularly, MPEP § 2106 provides,

**a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.**

This relationship has been further expressed in the additional language of Claim 70 which recites, "wherein said stream database is accessed by a reproducing device which controls a reproduction position on the basis of the STC sequence information and a desired access point". Thus, based on the clear language of this section, Claims 70 and 73 are statutory as they define a functionality of which is realized based on the interrelationship of the structure to the medium and recited hardware components.

Further, should the Examiner disagree with the above passage, MPEP § 2106 also states that,

Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Applicants respectfully submit, as noted above, that the rejection under 35 U.S.C. § 101 should be withdrawn. However, if the rejection under U.S.C. § 101 is to be maintained, applicants respectfully request that the Examiner provide an explanation of the rejection in view of the guidelines of MPEP § 2106.

Independent Claims 1, 15, 43, 44, 46, 54 and 70 were rejected under 35 U.S.C. §102(e) as anticipated by Nagata, and independent Claims 55, 57, and 68 were rejected under 35 U.S.C. §103(a) as unpatentable over Nagata. However, as discussed above, the subject matter of canceled Claims 3-4 is incorporated into independent Claims 1, 15, 43, 44, 46, 54, 55, 57, 68 and 70 respectively.

Claims 3-5, 10-14, 17-19, 24-28, 59-61, 63-67, and 71-73 were rejected under 35 U.S.C. §103(a) as unpatentable over Nagata in view of Fujinami. Applicant notes that Fujinami qualifies as prior art under 35 U.S.C. §102(e), as the present application filing date predates the issue date of Fujinami. To the extent the rejections above apply to the present claims, Applicant respectfully traverses the rejections.

As Fujinami is 102(e) art, the obviousness rejection is deficient under 35 U.S.C. §103(c) as explained below.

Applicants submit that the present application and the Fujinami reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to Sony Corporation. Accordingly, application of the Fujinami reference in this obviousness rejection is improper, as Fujinami may not be applied as a basis for supporting a prima facie case of obviousness as outlined by 35 U.S.C. §103(c).<sup>1</sup>

Amended Claim 1 is directed to a transport stream recording apparatus for recording a transport stream on a recording medium. The recording apparatus includes a detector which is configured to detect a system time clock (STC) discontinuity point from a transport packet included in the transport stream received by the recording apparatus. A generator is also provided which generates STC sequence information indicative of the sequence of transport packets that include no STC discontinuity in accordance with the STC discontinuity point. The STC sequence is defined by a time axis having a start point and an end point and the STC sequence information includes information corresponding to the time axis and corresponding start points and end points. The recording apparatus also includes a recording unit which is configured to record the transport packet onto the recording medium along with the STC sequence information.

Amended Claim 1 recites, *inter alia*, a transport stream recording apparatus, comprising:

“...a generator configured to generate STC sequence information..., wherein said STC sequence information includes information defining a time axis of an STC sequence and information corresponding to a start point and an end point of said time axis...”

Remaining independent Claims 15, 43, 44, 46, 54, 55, 57, 68 and 70 are amended to recite similar subject matter.

In rejecting Claims 3-4, the Official Action admits that Nagata fails to teach or suggest a generator which generates, as the STC sequence information, time axis

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<sup>1</sup> Applicant notes that the filing date of the present application is after November 29, 1999, therefore bringing the present application under the current guidelines for 35 U.S.C. §103(c) for excluding 102(e) art.

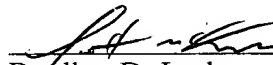
identification information for identifying a time axis and position information corresponding to a start time and end time of the time axis.<sup>2</sup> To address the deficiencies of Nagata the Official Action cites to Fujinami. However, as discussed above, Fujinami may not be applied as a basis for supporting a *prima facie* case of obviousness as outlined by 35 U.S.C. §103(c).

Accordingly as Nagata fails to teach or suggest the generation and storage of STC sequence information including information corresponding to a start point and an end point of a time axis which defines an STC sequence, Nagata can not properly be asserted as disclosing or suggesting Applicants' Claims 1-2, 5-6, 10-16, 19-20, 24-28, 43-44, 46-58, 61-70 and 73 which include the above distinguished limitations by virtue of independent recitation or dependency. Therefore, the Official Action does not provide a *prima facie* case of obviousness with regard to any of these claims.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-2, 5-6, 10-16, 19-20, 24-28, 43-44, 46-58, 61-70, and 73 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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<sup>2</sup> Official Action at page 9, item 8.